REMARKS/ARGUMENTS

1.   Claims 33, 42, 50, 55-56 and 58 were rejected under 35 U.S.C. 103(a) as unpatentable over Ogasawara (U.S. Patent No. 6,512,919) in view of Slater (U.S. Patent No. 6,157,435); and claims 34-41, 43-47 and 51-54 were rejected under 35 U.S.C. 103(a) as unpatentable over Ogasawara (U.S. Patent No. 6,512,919) in view of Slater (U.S. Patent No. 6,157,435) and further in view of Mault (U.S. Publication No. 2003/0208409); claim 57 was rejected under 35 U.S.C. 103(a) as unpatentable over Ogasawara (U.S. Patent No. 6,512,919) in view of Slater (U.S. Patent No. 6,157,435) and further in view of Rhoads (U.S. Patent No. 6,947,571). Claims 33-58 were also rejected under 35 USC 101 as recited nonstatutory subject matter.

Claims 33-58 are currently pending in this application. The rejections above have been traversed and, as such, the applicant respectfully requests reconsideration of the allowability of claims 33-58.

2.   As discussed above, claims 33 and 50 were rejected under 35 USC §101 as being directed to nonstatutory subject matter. The applicant respectfully traverses this rejection for each of the reasons below.

Claim 33 includes the following:

 capturing via a handheld cellular telephone and in response to actions of a user, a digital image of a location including a restaurant;

 displaying the digital image of the restaurant to the user on a display device of the handheld cellular telephone;

 interacting with the user to select the digital image;

Claim 50 includes the following:

 capturing via a handheld cellular telephone and in response to actions of a user, a digital image of an event venue;

> displaying the digital image of the event venue to the user on a display device of the handheld cellular telephone;

> interacting with the user to select the digital image;

The methods of claims 33 and 50 are tied to the operation of a particular machine (a handheld cellular telephone). In contrast to preamble limitations, the machine is expressly recited in various steps of these methods. In addition, claims 33 and 50 are not merely directed to "outputting" data, the method recites displaying the digital image on the display device of the handheld cellular telephone. This "displaying" transforms data from the handheld cellular telephone into a visual representation that can be viewed by the user. The nature of the data has been changed such that it has a different function or is suitable for different use. The display of the digital image allows user interaction to select the digital image. Further, these steps are not "extra-solution activity", they recite intermediate steps that lead to, for example, the recognition of a restaurant or event venue in the image, the retrieval and further display of information, etc.

For each of these separate reasons, claims 33 and 50, and claims 34-41 and 51-58 that depend therefrom, recite statutory subject matter. Applicant respectfully requests that this basis of rejection be withdrawn.

3.   As discussed above, claim 42 was also rejected under 35 USC §101 as being directed to nonstatutory subject matter. The applicant respectfully traverses this rejection for each of the reasons below.

> Claim 42 includes the following:

> > receiving a digital image of a restaurant captured with the wireless communication device;

> > receiving a selection of a task, wherein the task includes making reservations for the restaurant; and

> > identifying the restaurant, based on the recognition of the restaurant in the digital image, and not based on the recognition of an optical code;

>facilitating the making of the reservations for the restaurant via
>communication with the computer network and based on the identification
>of the restaurant, wherein the facilitating includes retrieving restaurant
>information.

The method of claim 42 is tied to the operation of a particular machine (a handheld cellular telephone). In contrast to preamble limitations, the machine is expressly recited in various steps of this method. The step of "identifying the restaurant, based on the recognition of the restaurant in the digital image" transforms data from the handheld cellular telephone. The nature of the data has been changed such that it has a different function or is suitable for different use. The recognition of a restaurant is used by the method to facilitate a particular task, that of making reservations. Further, these steps are not "extra-solution activity", they recite intermediate steps that lead to, for example, making reservations and retrieving restaurant information.

For each of these separate reasons, claim 42 and claims 43-49 that depend therefrom, recite statutory subject matter. Applicant respectfully requests that this basis of rejection be withdrawn.

4. As discussed above, claim 33 was rejected under 35 USC § 103 (a) as being anticipated by Ogasawara (U.S. Patent No. 6,512,919) in view of Slater (U.S. Patent No. 6,157,435). The applicant respectfully traverses this rejection for each of the reasons below.

A. Ogasawara is not a proper reference under *KSR* because the proposed combination lacks common-sense

KSR mandates that we consider a common-sense and market forces when assessing the obviousness of a given prior art combination. It is axiomatic, of course, that there is no more fundamental common-sense than to be competitive - "competition" indeed defines the modern "market." To be competitive, in turn, is to offer a product that offers a reasonable solution, compared to other alternatives. Here, however, the primary reference being relied upon for this combination is a distinctly noncompetitive offering

compared to a common-sense approach. In particular, this offering is unduly complex.

Ogasawara includes the following recital:

> In accordance with practice of the present invention, FIG. 13 illustrates an exemplary block level flow chart of the operation of the wireless videophone when used as a means of capturing image data through the integral digital camera, in accordance with a downloaded bar code image capture program. In accordance with the invention, and as was described above in connection with the first embodiment, a customer would interface with the store server using the wireless telephone portion of the system, identify themselves appropriately to the server and download an appropriate purchase transaction program which recognizes the video graphic image capture capability of the customer's wireless videophone.
>
> After a program load is complete, the newly received purchase transaction program overwrites any previously received program which was stored in the system's program memory. The program loader transfers control to the loaded purchase transaction program which initiates execution and assumes control over the system's peripheral I/O devices such as the keyboard 244, microphone 300, IC, card reader/writer 227, video graphic display 242 and digital video camera 236. The purchase transaction program also assumes control over all transmit and receive functions of the wireless videophone. [Col. 20, lines 17-40]

And further,

> It is desirable to download the purchase transaction program into a wireless videophone as needed, rather than to permanently store the purchase transaction program in the wireless videophone, because downloading allows a plurality of different sellers to utilize their own programs, rather than requiring a single, universal program for all sellers. It should be appreciated that different sellers will desire to incorporate different messages, advertisements, menus, etc. into their own purchase transaction program and to further customize their own purchase transaction program so as to tailor it to the particular products being sold.
>
> Further, since different types of wireless videophones are contemplated to have different displays, keypads, camera and display types, etc., it is desirable to download a purchase transaction program which is specifically tailored to a particular type of wireless videophone, so as to make the best use of that particular wireless videophone's features. [Col. 3, lines 31 – 48]

Ogasawara teaches:

> 1. A customer would interface with a store server using the wireless telephone portion of the system;

2. Identify themselves appropriately to the server;

3. Download an appropriate purchase transaction program which provides videographic image recognition capability to the customer's wireless videophone;

4. After a program download is complete, the newly received purchase transaction program overwrites any previously received program which was stored in the system's program memory;

5. Program loader transfers control to the loaded purchase transaction program which initiates execution and assumes control over the systems peripheral I/O devices;

6. The purchase transaction program also assumes control over all transmit and receive functions of the wireless videophone.

The examiner's read of Ogasawara in combination with Slater would appear to be that:

1. A customer would interface with a restaurant server using the wireless telephone portion of the system;

2. Identify themselves appropriately to the server;

3. Download an appropriate software to provide videographic image recognition capability in the customer's wireless videophone;

4. After a program download is complete, the newly received software overwrites any previously received program which was stored in the system's program memory;

5. A program loader transfers control to the loaded purchase transaction program which initiates execution and assumes control over the systems peripheral I/O devices, and further assumes control over all transmit and receive functions of the wireless videophone;

6. The program is used by the user to take a picture of the restaurant;

7. The picture is used to identify the restaurant so that the user can retrieve restaurant information and facilitate a reservation at the restaurant.

Such complexity, in turn, leads inexorably to increased cost of design as well as reduced reliability and delays in operation when the user waits to authenticate themselves

to a restaurant server, download software to his or her phone and run the software. The user is further inconvenienced by having the program <u>overwrite</u> other software and take control of the phone I/O and transceiver, so that, presumably, the phone cannot be used during the process.

This is <u>not</u> a common sense approach. If the restaurant has a server that can communicate with a user's phone, a <u>common sense approach</u> would be to <u>directly</u> download information on the restaurant, instead of downloading software to take control of the user's phone so that the user could capture an image of the restaurant in order to identify the restaurant. If the user has contacted the restaurant's server, the restaurant would not need to be identified. The restaurant's server could directly identify the restaurant at the first instance.

Being aware of market forces, and employing their own good common sense, the skilled artisan will therefore have no reason to pursue consideration of the teachings of Ogasawara in the manner that the Examiner has presented. The Supreme Court's admonitions in KSR therefore clearly <u>compel</u> a conclusion that an obviousness finding cannot be fairly based upon this reference. For this reason alone, applicant respectfully requests that this basis of rejection be withdrawn.

B. Ogasawara & Slater do not disclose identifying a restaurant, based on the recognition of the restaurant in the digital image of the location

Claim 33 includes the following recital:

> identifying <u>the restaurant, based on the recognition of the restaurant in the digital image of the location, and not based on the recognition of an optical code</u>;

In setting forth the basis of the rejection of this feature, the Examiner looks to Slater. While Slater makes a passing reference to buildings, Slater does not disclose the recognition of a restaurant <u>in the digital image of a location.</u> Recognizing a building, is not tantamount to identifying a restaurant that may or may not be housed in that building. Slater provides no guidance as to how the recognition of a building could lead to the

identification of a restaurant. More fundamentally, Slater does not address restaurants at all. For this additional reason, claim 33 and claims 34-41 that depend therefrom are believed to be patentably distinct from the prior art.

C. Ogasawara & Slater do not disclose either retrieving restaurant information or facilitating reservations for the restaurant

In setting forth the basis of the rejection of this feature, the Examiner looks to Ogasawara. While Ogasawara, refers to "ticket reservations" and "seat reservations" these references do not appear to pertain to restaurants. Examiner has made no showing that restaurants reservations require "tickets" or "seats". Indeed, restaurant reservations are commonly referred to as reserving "a table". In addition, Ogasawara refers to "food ordering", this also has nothing to do with restaurant reservations. It seems clear that Ogasawara did not have restaurant reservations in mind.

For this additional reason, claim 33 and claims 34-41 that depend therefrom are believed to be patentably distinct from the prior art.

5. As discussed above, claims 42 and 50 were also rejected under 35 USC § 103 (a) as being anticipated by Ogasawara (U.S. Patent No. 6,512,919) in view of Slater (U.S. Patent No. 6,157,435). The applicant respectfully traverses this rejection.

For similar reasons as set forth in the discussion of claim 33, claims 42 and 50 are believed to be patentably distinct from Ogasawara and Slater.

6. As discussed above, claims 34-41, 43-47 and 51-54 were rejected under 35 U.S.C. 103(a) as unpatentable over Ogasawara (U.S. Patent No. 6,512,919) in view of Slater (U.S. Patent No. 6,157,435) and further in view of Mault (U.S. Publication No. 2003/0208409). The applicant respectfully traverses this rejection.

In setting forth the basis of rejection, the Examiner applies the disclosure of the Publication No. 2003/0208409 (the "Mault Utility") that was filed on April 30, 2001, after the October 27, 2000 filing date of present application. While the Mault Utility claims priority to an earlier provisional filing on April 28, 2000 (the "Mault Provisional"), the disclosures of the Mault Utility are only prior art to the present application IF the disclosures cited by the Examiner are also disclosed in the Mault Provisional in such a fashion as to meet the standards set forth in 35 USC 112. The Examiner has made no such showing. Indeed, paragraphs of the Mault Utility cited by the Examiner refer to Figures 6 and 7 that are not included in the Mault Provisional. Applicant respectfully submits that the Examiner has not met his burden of demonstrating that Mault is a valid prior art reference since that there has been no showing that the sections relied upon in support of the rejection are supported by the Mault Provisional in a manner consistent with 35 USB 112. For these reasons, the Applicant respectfully requests that this basis of rejection be withdrawn.

7. Claim 56 was rejected under 35 USC § 103 (a) as being anticipated by Ogasawara (U.S. Patent No. 6,512,919) in view of Slater (U.S. Patent No. 6,157,435) and further in view of Official Notice. The applicant respectfully traverses this rejection.

In setting for the basis for this rejection, the Examiner admits that Ogasawara and Slater fail to teach that a ticket is ordered for a later date or ordered for a current date. However, the Examiner does not provide additional documentary support for the subject matter of this claim. Rejections unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. Applicant asserts that these features are not in "common knowledge in the art" or are capable of "instant and unquestionable demonstration as being well-known" in the context of the current claims, as of the filing date of the present application. Applicant respectfully traverses this rejection for this reason. If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner

must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding as set forth in M.P.E.P. 2144.03(c).

8. Claim 57 was rejected under 35 USC § 103 (a) as being anticipated by Ogasawara (U.S. Patent No. 6,512,919) in view of Slater (U.S. Patent No. 6,157,435) and further in view of Rhoads (U.S. Patent No. 6,947,571). The applicant respectfully traverses this rejection.

In particular, the Examiner relies upon Rhoads for support of "sending an email message. A portion of Rhoads is presented below.

> Product Information and Ordering 25 Product packaging and product advertisements can be encoded with Bedoop data that, when presented to a Bedoop system, initiates a link to a web page from which that product can be purchased, or more information obtained. Once the link has been established, the user can be instructed 30 to <u>manipulate the object in different of the earlier-described modes to effect different functions, e.g., move towards camera</u> to order the product; <u>move away from camera</u> for product information. If the object is moved towards the camera to effect an order, the user can be prompted to further 35 manipulate the object to specify delivery options (e.g., rotate left for overnight mail, rotate right for regular mail). If the object is moved away from the camera to request product information, the user can be promoted to further manipulate the object to specify the type of information desired (e.g., 40 rotate left for recipes, rotate right for FDA nutritional information, <u>move up for information on other products in this family, move down to send an email to the product manufacturer</u>).

In summary, Rhoads teaches <u>manipulating an object</u> to effect different functions; such as to <u>move an object down</u> to send an email to the product manufacturer. Rhoads clearly "teaches away" from the combination that the Examiner sets forth. Since the <u>object</u> in claim 57 is an "event venue" it would appear to be impossible for a user to <u>move an object (the event venue) down</u> to send an email. Common sense would dictate that the <u>event venue</u> would be immovable. The combination of Ogasawara, Slater and Rhoads is inoperable in this regard.

For this separate and independent reason, claim 57 is believed to be patentably distinct from the prior art.

Conclusions

For the foregoing reasons, the applicant believes that claims 33-58 are in condition for allowance and respectfully request that they be passed to allowance.

The Examiner is invited to contact the undersigned by telephone or facsimile if the Examiner believes that such a communication would advance the prosecution of the present invention.

No additional fees are believed to be due. Please charge any additional required fees to deposit account No. 502126 (WLR002).

RESPECTFULLY SUBMITTED,

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